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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,480	01/15/2004	Thomas J. Balkin	WRA 97-09F2CON2	4164
27370 7590 05/21/2008 OFFICE OF THE STAFF JUDGE ADVOCATE U.S. ARMY MEDICAL RESEARCH AND MATERIEL COMMAND ATTN: MCMR-JA (MS. ELIZABETH ARWINE) 504 SCOTT STREET FORT DETRICK, MD 21702-5012				
EXAMINER NASSER, ROBERT L				
ART UNIT 3735		PAPER NUMBER		
MAIL DATE 05/21/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/757,480

**Applicant(s)**

BALKIN ET AL.

**Examiner**

ROBERT L. NASSER

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 24-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-859)
- Paper No(s)/Mail Date 11/19/04, 10/17/05, 1/27/08

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The examiner acknowledges applicant's attempt to provoke an interference with Hursh patent 7118530 by copying claims 23-34 from that patent as filed. However, the only claims that were patented correspond to claim 24, adjusting the schedule based on an inputted parameter. However, it is the examiner's position that applicant's specification as filed, lacks support for claims 23-34. For example, the examiner sees no discussion of displaying a schedule based on pattern data in claims 23, 28, 29, 30 . The only discussion of schedules in the implementation of the method section, and it seems that any schedule there is made to optimize cognitive performance. As to claims 24-26 and 31-33, there is additionally no discussion or producing a second schedule after modifying a first parameter. As to claims 27, 28, and 34, the examiner sees no discussion of circadian oscillators and calculating an affective amount of sleep in a sleep reservoir.

These claims were original claims in the current application, the subject matter can be added to the specification, so long as new matter has been entered. However, since the subject matter is not supported by the earlier patents in application history, the filing date of claims 23-34 is the filing date of the current application, or January 15, 2004. This makes the Hursh patent available as a reference.

The examiner notes that, in accordance with the discussion above, the oath is objected to, as it is merely a copied declaration from 09/844434. A new

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oath is required, covering the new material in this case and listing the current case as a CIP, If applicant wishes to pursue the subject matter above.

Claims 23, 30, 32, and 33 are objected to. Claims 23 and 30 are objected to in that in line 6, there is no antecedent basis for sleep schedule data, as it was previously referred to a sleep pattern data. Claims 32 and 33 are objected to in that they dependent from claim 30, but the antecedent basis for their subject matter is in claim 31. For the purposes of examination, the examiner will treat claims 32 and 33 as being dependent on claim 31.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6241686. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims.

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6419629. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims.

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-60 of U.S. Patent No. 6527715. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims.

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6530884. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims.

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-51 of U.S. Patent No. 6553252. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because the current claims are broader versions of the patented claims.

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6740032. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims.

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6743167. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 23, 28, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore-Ede et al 5433223. Moore-Ede shows a system that

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determines cognitive performance, i.e. a modified alertness value from both circadian rhythm data and a cognitive level (baseline curve) based on sleep/wake data. As to claims 23, and 28-30, Moore-Ede receives sleep data as an input, determines an alertness curve (a measure of task performance), and outputs a schedule (see abstract) based on the sleep data.

Claims 23-34 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hursh et al 7118530.

Claim 35 is allowable in that none of the art selects the function from one of the recited functions, as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT L. NASSER whose telephone number is (571)272-4731. The examiner can normally be reached on m-f 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert L. Nasser Jr/  
Primary Examiner  
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RLN  
May 12, 2008